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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	09/615,473	
	Filing Date	07/13/2000	
	First Named Inventor	Marcus Escobosa	
	Art Unit	2612	
	Examiner Name	Zimmerman, Brian A.	
Total Number of Pages in This Submission	6	Attorney Docket Number	81230.56US1

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Escobosa	)	Examiner:	Zimmerman, Brian A.
		)		
Serial No.:	09/615,473	)	Art Unit:	2635
		)		
Filed:	July 13, 2000	)	Attny Doc.:	81230.56US1
		)		
Title:	Customizable And	)		
	Upgradeable Devices And	)		
	Methods Related Thereto	)		

SUPPLEMENTAL REPLY BRIEF

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Appellant hereby submits this Supplemental Reply to the Examiner's Supplemental Answer dated March 23, 2007.

This Supplemental Reply Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit overpayment to deposit account number 50-2428 in the name of Greenberg Traurig.

Certificate of Mailing: I hereby certify that this correspondence is being deposited with the U.S. Postal Service as First Class mail, postage prepaid, in an envelope addressed to: Mail Stop Appeal Briefs – Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 17th day of April, 2007.

By: \_\_\_\_\_

Ranni Matar

## REMARKS

In accordance with 37 CFR §§ 41.41(a)(1) and 41.43(b), Appellant hereby submits this Reply Brief in response to the Examiner's Answer.

It is respectfully submitted that the Examiner's Supplemental Answer continues to demonstrate that the rejection of the claims is, at best, based upon the impermissible use of hindsight reasoning and, as such, is required to be withdrawn.

In the Appellant's Reply Brief, it was argued that, among other things, no evidence has been provided to demonstrate that one of ordinary skill in the art at the time of the invention would have been motivated and led to modify Chiloyan to arrive at the exact invention that is set forth within the claims at issue. It is respectfully submitted that the Examiner's Supplemental Answer continues in failing to provide any such evidence.

Specifically, in the Appellant's Reply Brief the Appellant noted that no reference of record teaches or suggests that it would be desirable to increase the efficiency in the user experimentation phase of a remote control, let alone by downloading and testing only candidate codes sets as opposed to all possible code sets stored at a computer as is claimed. That no reference of record teaches or suggests this aspect of the claimed invention has been acknowledged within the Examiner's Supplemental Answer. Nevertheless, the Examiner has asserted that "the artisan at the time of the art would be well aware of the desirability to provide efficiency in the programming mode of a remote control since users definitely wouldn't want to spend hours programming their remote control" and, based upon this naked assertion, concluded that "any and all steps leading to increased efficiency in the programming of the remote control would have been desirable in a programmable remote control." (Supplemental Answer, page 4). As will be readily appreciated, such unsupported assertions and sweeping conclusions drawn

thereupon are simply not acceptable “evidence” with respect to demonstrating the obviousness of a claimed invention under 35 U.S.C. § 103.

While it is believed that the evidence of record fails to support a *prima facie* case of obviousness, it is nevertheless respectfully submitted that, even if it is assumed that those of skill in the art at the time of the invention “would be well aware of the desirability to provide efficiency in the programming mode of a remote control” as espoused by the Examiner, the Examiner’s Supplemental Answer continues to fail to explain how this awareness would necessarily lead one of skill in the art at the time of the invention to modify Chiloyan to thereby arrive at the exact invention that is specifically set forth within the claims at issue. Particularly, the Examiner’s Supplemental Answer continues in failing to offer any explanation as to how this espoused motivation for modifying Chiloyan would necessarily cause one of skill in the art to modify Chiloyan to provide for using input at a computer to select and download for testing with a remote control only candidate codes sets from a library of code sets stored at a computer as is claimed. Therefore, even though the Examiner’s Supplemental Answer argues that there exists some suggestion or motivation (albeit unsupported by any evidence of record) to modify Chiloyan as is required of a *prima facie* case of obviousness, the Examiner’s Supplemental Answer still continues to ignore the fact that no reference of record teaches or suggests the specific claim elements that have been acknowledged to be missing from Chiloyan in the first instance as is also required of a *prima facie* case of obviousness. (See MPEP § 2143). Since the subject application continues to be the sole reference of record that discloses, teaches, and suggests the claimed elements associated with downloading and testing only candidate codes from all possible code sets stored at a computer and, as such, is the sole reference of record that can be said to disclose, teach, or suggest the desirability of downloading and testing only

candidate codes from all possible code sets stored at a computer to meet the espoused objective of providing efficiency in the programming mode of a remote control, it is respectfully submitted that the Examiner's Supplemental Answer continues to evidence that the rejection of the claims could only have been arrived at through the impermissible use of hindsight reasoning. For at least these reasons it is respectfully submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

With respect to the discussion of Kemink in the Appellant's Reply Brief, it is respectfully submitted that considering Kemink in this instance is justified even though Kemink was not utilized in connection with the rejection of claim 54. In this regard, the Examiner has based the rejection of claim 54 upon supposed "knowledge generally available." Thus, the Appellant offered the teachings of Kemink - clearly one of skill in the art - to demonstrate that, contrary to the position taken by the Examiner, "knowledge generally available" would not necessarily cause one of skill in the art to modify Chiloyan to arrive at the exact invention claimed even if motivated to do so for the reasons espoused by the Examiner. Rather, when Kemink is considered as being representative of "knowledge generally available," it has been demonstrated that, if one desired "to provide efficiency in the programming mode of a remote control" as espoused by the Examiner, one would likely be led to remove the user experimentation phase of Chiloyan in favor of the downloading from a computer to a remote control of a single command set that is determined by a system, such as disclosed within Kemink, to be appropriate for commanding operations of a consumer electronic device thereby arriving at a system that is in direct contrast to the invention claimed. Thus, it is respectfully submitted that the discussion of Kemink within the Appellant's Reply Brief makes perfect sense as it provides concrete evidence of "knowledge generally available" (unlike the Examiner's unsupported assertions and

conclusions) as well as evidence of how one of skill in the art would modify Chiloyan to meet the objectives espoused by the Examiner were one of skill in the art to modify Chiloyan to this end *without the benefit of the teachings of the subject application* as is required when rendering a determination of obviousness under 35 U.S.C. § 103.

It is for all of these reasons - as well as those set forth in the Appellant's Reply Brief and Appeal Brief - that it is respectfully submitted that the rejection of the claims must be withdrawn.

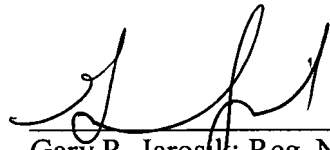
Conclusion

It is again respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

Date: April 17, 2007

By:



Gary R. Jarosik; Reg. No. 35,906  
Greenberg Traurig, LLP  
77 W. Wacker Drive, Suite 2500  
Chicago, Illinois 60601  
(312) 456-8449

## REMARKS

In accordance with 37 CFR §§ 41.41(a)(1) and 41.43(b), Appellant hereby submits this Reply Brief in response to the Examiner's Answer.

It is respectfully submitted that the Examiner's Supplemental Answer continues to demonstrate that the rejection of the claims is, at best, based upon the impermissible use of hindsight reasoning and, as such, is required to be withdrawn.

In the Appellant's Reply Brief, it was argued that, among other things, no evidence has been provided to demonstrate that one of ordinary skill in the art at the time of the invention would have been motivated and led to modify Chiloyan to arrive at the exact invention that is set forth within the claims at issue. It is respectfully submitted that the Examiner's Supplemental Answer continues in failing to provide any such evidence.

Specifically, in the Appellant's Reply Brief the Appellant noted that no reference of record teaches or suggests that it would be desirable to increase the efficiency in the user experimentation phase of a remote control, let alone by downloading and testing only candidate codes sets as opposed to all possible code sets stored at a computer as is claimed. That no reference of record teaches or suggests this aspect of the claimed invention has been acknowledged within the Examiner's Supplemental Answer. Nevertheless, the Examiner has asserted that "the artisan at the time of the art would be well aware of the desirability to provide efficiency in the programming mode of a remote control since users definitely wouldn't want to spend hours programming their remote control" and, based upon this naked assertion, concluded that "any and all steps leading to increased efficiency in the programming of the remote control would have been desirable in a programmable remote control." (Supplemental Answer, page 4). As will be readily appreciated, such unsupported assertions and sweeping conclusions drawn

thereupon are simply not acceptable “evidence” with respect to demonstrating the obviousness of a claimed invention under 35 U.S.C. § 103.

While it is believed that the evidence of record fails to support a *prima facie* case of obviousness, it is nevertheless respectfully submitted that, even if it is assumed that those of skill in the art at the time of the invention “would be well aware of the desirability to provide efficiency in the programming mode of a remote control” as espoused by the Examiner, the Examiner’s Supplemental Answer continues to fail to explain how this awareness would necessarily lead one of skill in the art at the time of the invention to modify Chiloyan to thereby arrive at the exact invention that is specifically set forth within the claims at issue. Particularly, the Examiner’s Supplemental Answer continues in failing to offer any explanation as to how this espoused motivation for modifying Chiloyan would necessarily cause one of skill in the art to modify Chiloyan to provide for using input at a computer to select and download for testing with a remote control only candidate codes sets from a library of code sets stored at a computer as is claimed. Therefore, even though the Examiner’s Supplemental Answer argues that there exists some suggestion or motivation (albeit unsupported by any evidence of record) to modify Chiloyan as is required of a *prima facie* case of obviousness, the Examiner’s Supplemental Answer still continues to ignore the fact that no reference of record teaches or suggests the specific claim elements that have been acknowledged to be missing from Chiloyan in the first instance as is also required of a *prima facie* case of obviousness. (See MPEP § 2143). Since the subject application continues to be the sole reference of record that discloses, teaches, and suggests the claimed elements associated with downloading and testing only candidate codes from all possible code sets stored at a computer and, as such, is the sole reference of record that can be said to disclose, teach, or suggest the desirability of downloading and testing only



candidate codes from all possible code sets stored at a computer to meet the espoused objective of providing efficiency in the programming mode of a remote control, it is respectfully submitted that the Examiner's Supplemental Answer continues to evidence that the rejection of the claims could only have been arrived at through the impermissible use of hindsight reasoning. For at least these reasons it is respectfully submitted that the rejection under 35 U.S.C. § 103 must be withdrawn.

With respect to the discussion of Kemink in the Appellant's Reply Brief, it is respectfully submitted that considering Kemink in this instance is justified even though Kemink was not utilized in connection with the rejection of claim 54. In this regard, the Examiner has based the rejection of claim 54 upon supposed "knowledge generally available." Thus, the Appellant offered the teachings of Kemink - clearly one of skill in the art - to demonstrate that, contrary to the position taken by the Examiner, "knowledge generally available" would not necessarily cause one of skill in the art to modify Chiloyan to arrive at the exact invention claimed even if motivated to do so for the reasons espoused by the Examiner. Rather, when Kemink is considered as being representative of "knowledge generally available," it has been demonstrated that, if one desired "to provide efficiency in the programming mode of a remote control" as espoused by the Examiner, one would likely be led to remove the user experimentation phase of Chiloyan in favor of the downloading from a computer to a remote control of a single command set that is determined by a system, such as disclosed within Kemink, to be appropriate for commanding operations of a consumer electronic device thereby arriving at a system that is in direct contrast to the invention claimed. Thus, it is respectfully submitted that the discussion of Kemink within the Appellant's Reply Brief makes perfect sense as it provides concrete evidence of "knowledge generally available" (unlike the Examiner's unsupported assertions and



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Escobosa	)	Examiner:	Zimmerman, Brian A.
		)		
Serial No.:	09/615,473	)	Art Unit:	2635
		)		
Filed:	July 13, 2000	)	Attny Doc.:	81230.56US1
		)		
Title:	Customizable And	)		
	Upgradeable Devices And	)		
	Methods Related Thereto	)		

SUPPLEMENTAL REPLY BRIEF

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By: \_\_\_\_\_

  
Ranni Matar

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